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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,735	03/06/2002	Hongbiao Li	5011-0006	9762

7590 12/28/2004
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EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT PAPER NUMBER

2635

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,735

Applicant(s)

LI, HONGBIAO

Examiner

Edwin C. Holloway, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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EXAMINER'S RESPONSE

1. In response to the application filed 3-6-2002 the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 102 & 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Molee (US 5267756). Molee discloses an authentication system and method in which consumer (customer) communicates (by telephone) a product code from a tag (hologram) on a product purchased by the consumer to an authentication agency (database or list) that indicates authenticity of the product. See col. 2 line 4 col. 3 line 2.

5. Claims 1 and 6-7 are rejected under 35 U.S.C. 102(e or a) as being anticipated by Zorab (US20030177095 or WO01/99063). Zorab discloses an authentication system and method in which a consumer communicates (by computer form/screen) a product code (validation reference) from a tag on a product (item) purchased by the consumer to an authentication agency (central authentication database) that indicates authenticity of the product. See paragraphs 0018-0024 and 0076 of the US Publication and corresponding paragraphs of the PCT document.

6. Claims 2, 4-5, 8-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molee (US 5267756 or Zorab (US20030177095 or WO01/99063) in combination with Shoshani (US

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3833795). Shoshani discloses means and method to authenticate objects using a pair of numbers (identification number and control number) corresponding to the claimed identification number and product code. The pair of numbers are read from an object and communicated to an authentication computer storing associated pairs of numbers for comparison and indication of authenticity. If the control number corresponding to the read identification number matches the read control number, the item is authentic. The numbers may be visible or not visible and may be read by humans. The control number may be changed so authentication code is only used once. This increases security against counterfeiting. See col. 1 line 1 - col. 3 line 60. Regarding claims 2, 4, 8 and 11, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Molee or Zorab the communication of a pair of numbers corresponding to identification number and product number to the authentication agency as disclosed in Shoshani to increase security. Regarding claim 5, one time use would have been obvious in view of the "not used again" in col. 2 lines 18-20 of Molee, the "authentic, unless the VR has already been registered elsewhere" in paragraph 0024 of Zorab and "modifying the control number each time the authenticity of an object is checked" in col. 3 lines 46-54 of Shoshani to

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further increase the difficulty of counterfeiting. Regarding claim 9, hidden would have been obvious in view of the alternative "visible or not visible" in Shoshani.

7. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molee (US 5267756 or Zorab (US20030177095 or WO01/99063) in combination with Shoshani (US 3833795) as applied above in view of Young (US 6591252) or Goldman (US 4191376). Young discloses authentication apparatus and method with product code obscured by packaging or tamper proof removable seal or scratch of material in col. 7 lines 9-12. Goldman discloses an analogous art authentication apparatus and method with product code 18 concealed by a scratch of strip 20 in col. 5 line 33 - col. 6 line 43 and col. 10 line 44 - col. 11 line 11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the product code concealed by a removable stripe as disclosed in Young or Goldman to further increase the difficulty of counterfeiting.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Katz (US 4558318), Knop (US 4661983), Moore (US 5592561), Kaish (US 5974150) and Doljack (US 6442276) were cited in the parent

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application. Storch (US 5367148), Mills (US 5372386) and Coppersmith (US 6069955) discloses anti-counterfeit systems.

CONTACT INFORMATION

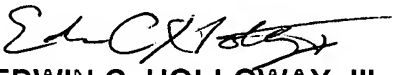
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via fax number (703) 872-9306 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
12/10/04


EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
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